

REMARKS

Applicant submits the following remarks in response to the Office Action dated April 15, 2005. Claims 1-54 remain pending. Claims 1, 15, 27, 32-34, 41-42, 44, 49, and 54 have been amended and claims 2, 16, 31, 35, and 52 have been canceled without prejudice. Claim 1 has been amended to include claims 2 and 16; claim 27 has been amended to include claims 31 and 35; and claim 42 has been amended to include claim 52. Claims 15 and 44 have been amended to update their dependency from now-canceled claim 2 to claim 1; claims 32-34, 41, and 49 have been amended to update their dependency from now-canceled claim 31 to claim 27; and claim 54 has been amended to correct a typographical error. No new matter has been introduced into the application by this amendment and no new issues are raised requiring further consideration or search by the Examiner. Entry of this amendment and allowance of the pending claims is respectfully requested.

Previous Amendment

Applicant notes that in the amendment filed December 8, 2004, Applicant requested that technical changes to the specification and page 2 of the drawings be entered for the sake of clarity. Applicant requests confirmation that these changes have been approved and entered.

Rejections under 35 U.S.C. § 103(a)

Claims 1-54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,605,024 to Sucato et al. ("Sucato") in view of U.S. Patent Nos. 5,913,788 to Herren ("Herren") and 5,527,625 to Bodnar ("Bodnar"). Applicant respectfully requests withdrawal of this rejection. Claims 1, 17, 27, 42, 53 and 54 are independent.

Claims 1, 27, and 42

Applicant has discovered a metal framing member including a plurality of expanded web slots having reinforcements including one dart or dimple proximate to the expanded web slots. See claims 1, 27, and 42. The Examiner states that Sucato discloses each element of claims 1, 27 and 42 except a plurality of reinforcements proximate to the web slots, which the Examiner urges are taught by both Bodnar and Herren.

The combined references fail to teach all elements of claims 1, 27, and 42. Applicant agrees with Examiner that Sucato fails to teach a plurality of reinforcements proximate to the

web slots. Sucato also fails to disclose reinforcements including a dart or dimple proximate to the expanded web slots as recited in claims 1, 27, and 42 as amended. Neither Bodnar nor Herren discloses providing a plurality of reinforcements including a dart or dimple proximate to expanded web slots. Bodnar describes a metal member having corner flanges 100, 104 in the corners of generally triangular openings 92. See col. 6, line 55 - col. 7, line 2; FIG. 5. Bodnar also describes generally three-sided depressions such as depressions 42, 44 formed in a strut portion 28 of the disclosed member. See col. 6, lines 10-13; FIG. 1. Bodnar does not describe a plurality of reinforcements including a dart or dimple proximate to expanded web slots as recited in claims 1, 27, and 42. The Examiner has not identified any reinforcement or dart or dimple disclosed in Herren, which relates to a fire- and seismic-resistant wall structure. Indeed, Herren appears not to disclose a plurality of reinforcements including a dart or dimple proximate to web slots as recited in claims 1, 27, and 42.

Moreover, the elements missing in Sucato are incorrectly drawn by the Examiner from Bodnar and Herren. Neither Sucato, nor Bodnar, nor Herren contains any motivation or suggestion to combine the teachings of the references. The Examiner has not established that one of ordinary skill in the art would modify an invention related to a stud assembly having an expandable mesh connector (Sucato) based on the teachings of references that do not include any expandable mesh or slots (Bodnar and Herren).

For at least these reasons, claims 1, 27, and 42 are allowable over Sucato in view of Bodnar and Herren. Since claims 3-15 and 44 depend from claim 1; claims 28-30, 32-34, 36-41, and 49-50 depend from claim 27; and claims 43, 47-48, and 51 depend from claim 42, these claims are allowable for at least the reasons described above. Applicant requests that this rejection be reconsidered and withdrawn.

Claim 17

As noted in Applicant's amendment filed December 8, 2004, Applicant has discovered a preexpanded metal framing member including from two to five columns of web slots extending along a portion of the length of the member. See claim 17; FIG. 7-9. Sucato, in contrast, discloses "a pair of U-shaped members 62 and 63 which may be formed of a metallic material that are interconnected by bight 64 comprising an expandable mesh 65." See col. 4, lines 22-25. While claim 17 recites two to five columns of slots, the mesh disclosed in Sucato requires

forming at least eight separate and distinct columns of slots. See FIG. 20-21. Sucato fails to disclose a metal framing member including from two to five columns of web slots.

This missing element cannot be properly drawn from Bodnar or Herren. First, neither reference teaches including from two to five columns of web slots extending along a portion of the length of a framing member. Second, as described above, the teachings of Bodnar and Herren are not properly combinable with the teachings of Sucato, as there is no motivation or suggestion provided by the Examiner or contained within the references to combine Sucato with Bodnar or Herren. For at least these reasons, claim 17 is not anticipated by Sucato. Since claims 18-26 and 45-46 depend from claim 17, these claims are allowable for at least the reasons described above. Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Claim 53

The Examiner previously indicated that the subject matter of heat treating the claimed metal framing matter is patentable (see September 8, 2004 Office Action, page 3), yet now rejects claim 53, which recites heat treating a frame member after expanding the slots, as obvious over Sucato in view of Bodnar and Herren. Heat treating web slots in a formed metal sheet is not taught by any of these references. The Examiner does not suggest--and Applicant agrees--that neither Sucato nor Herren teaches heat treating expanded web slots in a formed metal sheet. The Examiner incorrectly asserts that Bodnar teaches this element, referring to col. 7, line 50 - col. 8, line 65. This portion of Bodnar actually discloses that the described member can be formed from cold rolled or hot rolled steel. Bodnar does not disclose heat treating expanded web slots in a formed metal sheet. Additionally, as described above, there is no motivation or suggestion to combine the teachings of Sucato with the teachings of Bodnar and Herren. For at least these reasons, claim 53 should be allowed. Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Claim 54

Claim 54, which recites a metal framing member having expanded web slots that are heat treated, also stands rejected as obvious over Sucato in view of Bodnar and Herren. As discussed above with reference to claim 53, none of these references discloses expanded web slots that have been heat treated. Furthermore, as noted, the combination of these references is improper.

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For at least these reasons, claim 54 should be allowed. Applicant respectfully requests that this rejection be reconsidered and withdrawn.

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CONCLUSION

In light of the foregoing amendments and remarks, Applicant respectfully requests that the pending claims be allowed and the application pass to issuance. No fee is believed to be required with the filing of this amendment. However, the Commissioner is authorized to apply any charges or credits to deposit account 19-4293.

Respectfully submitted,

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